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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,556	02/27/2004	Anthony George Burns	0108-0245	9235
33787 7590 06/16/2009 JOHN J. OSKOREP, ESQ. LLC ONE MAGNIFICENT MILE CENTER 980 N. MICHIGAN AVE. SUITE 1400 CHICAGO, IL 60611			EXAMINER BAYOU, YONAS A	
			ART UNIT 2434	PAPER NUMBER
			NOTIFICATION DATE 06/16/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/789,556	<b>Applicant(s)</b> BURNS, ANTHONY GEORGE	
	<b>Examiner</b> YONAS BAYOU	<b>Art Unit</b> 2434	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 32-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 32-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02/27/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This office action is in response to applicant's response filed on 04/09/2009.
2. Claims 1-22 and 32-34 are pending.
3. Claims 1, 4, 11, 12 and 15 are amended.
4. Claims 23-31 are canceled.
5. Applicant's amendment necessitated the new 35 USC § 112 first paragraph rejection (see below).
6. Applicant's arguments have been fully considered but they are not persuasive.

### **Response to Arguments**

1. Applicant, on page 9, last paragraph, of the remarks, argues "the prior arts in combinations do not teach the acts of "reading," "storing," and "repeating" which are performed "automatically" and "without prompting" ... "in response to detecting a trigger signal" for such user-specific information items as claimed in claims 1-22.

Examiner respectfully disagrees and asserts that Minborg discloses having detected a triggering event, the application residing on the SIM may invoke several actions. According to a first variant of the invention, the application sends an SMS to a data object server 130. In response to this, the data object server 130 sends a response to the UE 100 using an SMS message that is shown on the UE 100. According to a second variant of the invention, the data object server 130 sends a response using

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WAP Push technology as described in the WAP standard (www.wapforum.org, WAP-165, Push Architectural Overview) **[23:47-57 and fig. 1]**; detecting a trigger event in a UE 100 (user equipment) equates detecting, at the mobile station, a trigger signal] and Jin discloses reading... [para. 40 and figs. 4a-4f; reading a first user-specific info. equate displaying in a LCD the user personal information]; storing... **[para. 5, lines 3-8;** storing the first user-info. equate mobile telephones can be used to store phone number and personal info. management]; repeating which are performed "automatically"... [paras. 28, 31 and figs. 4A-4F; inputting the personal info. equate repeating the act of reading/displaying mobile terminal user's name, telephone number, home address, business, business address, and email address].

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Examiner notes: "without prompting" was not described in the specification.

Examiner has considered "without prompting" as -automatically- for examination purposes.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-22 and 32-34 are rejected under 35 U.S.C. 103(a) as being obvious over Jin, Pub. No. US 2002/0084888 A1 in view of Minborg, Patent No.: US 6,977,909 B2.

Referring to claims 1, 4-7, 12, 15-16, 32-34, Jin teaches a method for use in a mobile station for automatically grouping user-specific information items, each user-specific information item being for use in identifying or contacting a user of the mobile station, the method comprising the acts of:

in response to a trigger signal, automatically grouping the user-specific information items by a processor of the mobile station by **[paragraphs 30-31; inputting corresponding to grouping]**:

reading from a first file of the mobile station, a first user-specific information item for identifying or contacting the user **[paragraph 28, lines 1-2; paragraph 39, lines 1-**

**4; paragraph 40, lines 1-3 and figs. 4a-4f**; display/reading a first user-specific information item which corresponding to a personal information in a window of a mobile terminal];

storing the first user-specific information item in a user information file or a message of the mobile station [**paragraph 5, lines 3-8 and paragraph 11, lines 11-14**; stores more items/ first user-specific information item]; and

repeating the acts of reading, from a second file of the mobile station, at least a second user-specific information item for identifying or contacting the user, and storing, in the user information file or the message, the at least a second user-specific information item, so that the first and the second user-specific information items are automatically grouped together as user information in the user information file or the message

**[paragraphs 28, 30, 40 and figs. 4A-4F]**. Jin does not appear to explicitly teach a method wherein detecting, at the mobile station, a trigger signal and the trigger signal is based on an expiration of timer. However, Minborg discloses having detected a triggering event, the application residing on the SIM may invoke several actions **[23:47-57 and fig. 1]**. Minborg further teaches a possible interrupt may occur, e.g., when a user wishes to no longer wait for a complete download of a phonepage and instead initiates the circuit switched communication. This may be initiated by a time expiring or by manually indicating on a man-machine interface (MMI) **[column 19, lines 3-8]**. Jin and Minborg are analogous art because both teach exchanging of information in a communication network.

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At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the method of Jin to include time expiring or by manually indicating on a man-machine interface (MMI) of Minborg because the circuit switched communication is initiated when there is no more phonepage data to download or when a possible interrupt occurs.

Referring to claims 2, and 13, Jin teaches a mobile station, a method of grouping user-specific information items, wherein each one of the first and the second user-specific information items comprises one of the following items: a user name associated with an end user of the mobile station; a telephone number of the mobile station; an e-mail address associated with an e-mail communication application of the mobile station; a Personal Identification Number (PIN) of the mobile station; and an address associated with the end user of the mobile station **[paragraph 28]**.

Referring to claims 3 and 14, Jin teaches a mobile station, a method of grouping user-specific information items, wherein the first user-specific information item comprises a Personal Identification Number (PIN) of the mobile station **[paragraph 28]**.

Referring to claim 8, Jin teaches a mobile station, wherein the user information file or the message comprises the user information file and the method further comprises: sending the user information file as an attachment to a message to one or more recipients via a wireless communication network **[paragraph 16]**.

Referring to claims 10 and 20, Jin teaches a mobile station, a method of grouping user-specific information items, wherein the trigger signal is produced in response to a user input request for the user information **[paragraph 7; paragraph 42 , lines 1-4; the command “confirm” icon do the act of reading, storing, and repeating]**.

Referring to claims 11 and 22, Jin teaches a mobile station, a method of grouping user-specific information items, wherein the trigger signal is produced in response to an update to a user-specific information item **[paragraphs 5, 18, 38 and 50]**.

Referring to claims 17 and 18, Jin teaches a mobile station, wherein the processor is further operative to:

cause the user information file or the message to be sent through the wireless transceiver to one or more recipients **[paragraph 7; paragraph 30; paragraph 42 , lines 1-4 and fig. 2]**.

Referring to claims 9 and 19, Jin as modified teaches a mobile station, wherein the trigger signal is based on an expiration of a timer **[Minborg: 19:3-8]**.

Referring to claim 21, Jin as modified teaches a mobile station, wherein the first user-specific information item comprises an International Mobile Subscriber



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identification (IMSI) and the memory comprises at least a Subscriber Identity Module (SIM) or Removable User Identity Module (R-UIM) **[Minborg: 19:60-62]**.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YONAS BAYOU whose telephone number is (571)272-7610. The examiner can normally be reached on m-f, 7:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on 571-272-3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Yonas Bayou/

Examiner, Art Unit 2434

06/09/2009

/Kambiz Zand/

Supervisory Patent Examiner, Art Unit 2434